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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,259	09/22/2003	Steven Sigler	32581-2002	9033

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EXAMINER
CHAMBERS, MICHAEL S

ART UNIT	PAPER NUMBER
3711	

Torys LLP
Suite 3000, 79 Wellington Street West
Box 270, TD Centre
Toronto, ON M5K 1N2
CANADA

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/666,259	SIGLER, STEVEN	
	Examiner	Art Unit	
	Mike Chambers	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 June 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2 and 49-86* is/are pending in the application.

4a) Of the above claim(s) *3-48* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 49-86* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The previous office action inadvertently left off a section of the office action, this supplemental office action is being issued to replace the previous office action.

Election/Restrictions

Applicant's election without traverse of claims 1-2 in the 6/23/04 response is acknowledged. Claims 3-48 are withdrawn from further consideration, as directed to claims non-elected without traverse , 37CFR1.142.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> **Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.**

Claims 1,2,49-86 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order to be eligible for a patent, the invention has to fall into one of the following categories- a process, a machine, a manufacture process, or a composition of matter. In order to answer this question, the first question to be answered is: "What did the applicant invent?". The applicant has taken a well known game and simply altered the rules, not any structure (See claim 1). The novelty here is the game of baseball with altered game rules. The altering of the game of claim one does not fall into either of the four accepted statutory categories of invention (a process, a machine, a manufacture, or a composition of matter). As for the technological arts, what applicant actually invented is altered rules, and altered rules involve no substantive technology. Those elements, such as bases, manifestly

necessary to the game are peripheral to the rules themselves. Thus a baseball game with altered rules, or with unaltered rules, is not itself within the technological or useful arts.

Claims 1,2,49-86 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. In order for an invention to be patentable, it has to fall within the technological arts and have a practical application result. In the instant invention, a baseball game with altered rules is an abstraction that yields no real world value. In other words, the invention needs to have a useful, concrete, tangible result which is not present in rule modifications. The mere listing of rules or altering the rules of a game does not provide a tangible result, therefore it does not fall in the technological arts area. As for the technological arts, what applicant actually invented is altered rules, and altered rules involve no substantive technology. Those elements, such as bases, manifestly necessary to the game are peripheral to the rules themselves. Thus a baseball game with altered rules, or with unaltered rules, is not itself within the technological or useful arts.

Although the invention as claimed does not fall within the technological arts for the reasons listed above, if the applicant traverses this rejection, the following additional rejections are made.

Information Disclosure Statement

The applicant is reminded of their duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

Applicant has shown a thorough knowledge of terms and game rules for baseball/softball in formulating the specification and claim language. It would appear that the applicant would be aware of relevant documents. The applicant may be requested to furnish additional information pursuant to Rule 105 in a future action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 80-86 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "reduced injury factor ball" is vague and indefinite. One of ordinary skill in the art would not be able to determine the metes and bounds of the invention.

Claims 81-86 inherit the deficiencies of claim 80.

Oath/Declaration

The examiner has noted on the applicant's website that the press releases concerning the invention makes note of a co-inventor of the game. The examiner requests clarification of this apparent discrepancy between the oath and the published news reports.

Bee Regional Staff
Published 2:15 a.m. PDT
Thursday, June 5, 2003

Twenty-four senior men played the first exhibition fastball game at Sun City Lincoln Hills on Saturday.
Fastball, a game invented by Val Lewis of Elk Grove and Steve Sigler of New York, blends features of baseball and softball and can be played by people of any age or gender.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by CSCC Fast Pitch. CSCC Fast Pitch discloses a fastball game (page1, item 9). The method claimed would naturally be used by one playing the game of baseball.

Also,

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Pitching101. Pitching101discloses a fastball game (page1). Regarding the claimed feature of a fastball, in as much structure set forth by the applicant in the claims, the playing of a normal baseball game is capable of use in the intended manner if so desired (See MPEP 2112). As noted in the pitching101 reference the normal speed of a pitched ball is in the range of 50-91 mph. A ball pitched in this fashion can be considered a fastball since the claim language provides no structure. The method claimed would naturally be used by one playing the game of baseball.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman. Freeman discloses the elements of claim 1, however it fails to clearly disclose the use of fastballs. Minor variations in the rules by teams are well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to have restricted the balls pitched by the pitcher to be "fastballs" in order to insure the balls cross the home plate and permit the game to be played. The method claimed would naturally be used.

As to claim 2: Freeman discloses throwing a ball (page 1-2:2). Minor variations in the rules by teams are well known in the art. If the pitcher throws a ball that is hit by the batter or is called a "ball" the base hit or ball call is considered to be a penalty for not throwing an appropriate strike. It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the method of issuing a penalty to a pitcher for pitching an out of spec pitch in order to insure the teams comply with the rules agreed to for playing the game.

Claims 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman and further in view of Official Notice. Official notice it taken that it is well known to form divisions based on age and gender . It would have been obvious to one of

ordinary skill in the art at the time of the invention to have formed divisions in order to provide some structure to the games played and insure players are equally matched. The method claimed would naturally be used.

Claims 52 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman and further in view of Official Notice. Official notice it taken that it is well known to form divisions. The selection of players by pitching speed is considered an obvious variation based on design choice. Minor variations in the rules by opposing teams are well known in the art. The specification provides no unexpected results in selecting divisions by pitching speed. It would have been obvious to one of ordinary skill in the art to have selected an appropriate pitching speed in order to permit the teams to be equally matched.

As to claims 54 and 55: Freeman discloses throwing a ball (page 1-2:2). Minor variations in the rules by teams are well known in the art. If the pitcher throws a ball that is hit by the batter or is called a "ball" the base hit or ball call is considered to be a penalty for not throwing an appropriate strike. It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the method of issuing a penalty to a pitcher for pitching an out of spec pitch in order to insure the teams comply with the rules agreed to for playing the game.

. Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman and further in view of Official Notice. Official notice it taken that it is well known in some ball games to walk a batter after a predetermined number of pitches It would

have been obvious to one of ordinary skill in the art at the time of the invention to have used this rule to facilitate the game. The method claimed would naturally be used.

Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman and further in view of Official Notice. Minor variations in the rules by opposing teams are well known in the art. It would have been obvious to one of ordinary skill in the art to have selected an appropriate set of rules in order to keep the game interesting. The method claimed would naturally be used.

As to claims 58-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman and further in view of Official Notice. Minor variations in the rules by opposing teams and use of bases, bats and balls are well known in the art. It would have been obvious to one of ordinary skill in the art to have selected an appropriate set of rules and equipment in order to keep the game interesting and safe. The method claimed would naturally be used.

Note: The number of claims in this application appears to be excessive. Minor rules or equipment variations are obvious variations of a traditional well known game and are not patentable due to obviousness. The examiner has included several patents that deal with methods of playing a ball game for the applicant's review.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Chambers whose telephone number is 703-306-5516. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 23, 2004

GREGORY VIDOVICH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700